



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,326	03/04/2002	Tony E. Godfrey	010211	5534

26285 7590 06/17/2003

KIRKPATRICK & LOCKHART LLP  
535 SMITHFIELD STREET  
PITTSBURGH, PA 15222

EXAMINER

WILDER, CYNTHIA B

ART UNIT

PAPER NUMBER

1637

7

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/090,326

Applicant(s)  
Godfrey et al.

Examiner  
Cynthia B Wilder

Art Unit  
1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 23, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-77 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1637

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-66, drawn to a PCR method, classified in class 435, subclass 91.1.
  - II. Claims 67, 73-76 drawn to an oligonucleotide and cartridge (kit), classified in class 536, subclass 24.33.
  - III. Claims 68-72, 77, drawn to a diagnostic method, classified in class 435, subclass 6.

### ***Sequence Election Requirement Applicable to Groups I and II***

In addition, Groups I and II detailed above reads on patentably distinct SEQ ID Number sets. Each of the sequences or set of sequences are patentably distinct because the sequences are structurally unrelated sequences and a further restriction is applied to the Groups listed above. Applicant must further elect a first primer set (2 sequences) and a second primer set (2 sequences) comprising 4 SEQ ID numbers selected from SEQ ID NOS: 3, 4, 6, 7, 11, 12, 13, 14, 16, 17, 19 and 20 to be examined if the group I or group II is elected.

**Applicant is advised that examination will be restricted to only the elected 4 sequences (SEQ ID NOS) consisting of the first and second primer sets along with the corresponding elected group I or group II.**

**Applicant is also advised that this election should not be construed as a species election.**

Art Unit: 1637

2. The inventions are distinct, each from the other because of the following reasons: ~~Inventions~~ I, III and II are related process of use and product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the oligonucleotide and cartridge comprising primers of invention II can be used in a materially different process such as in mini-sequencing assays to detect a polymorphic variant in a sample or in methods of mutagenesis or in methods of nucleic acid cloning..

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different starting reagents different method steps leading to different objectives. For example, the PCR method comprising multiplex PCR and RT-PCR of invention I can function in methods of amplification to detect or classify microorganism or viral species. The method can also be used in purification procedures or in methods of detecting chromosomal imbalance whereas the method of invention III is drawn to a diagnostic method using PCR amplification to determine expression of an indicator transcript as compared to a threshold level. Likewise the search of the different inventions are not coextensive because diagnostic methods are not necessary combined with or required for the function of PCR methods. The different methods are patentably distinct requiring different fields of search.

Art Unit: 1637

4. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

5.. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 9:30 am to 6:30 pm and on Friday from 9:30 am to 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached at (703) 308-1119. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Group's receptionist at (703) 308-0196.

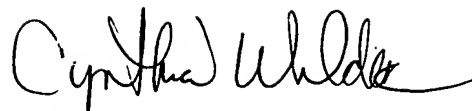
Application/Control Number: 10/014,012

Page 5

Art Unit: 1637

cbw

June 16, 2003

A handwritten signature in black ink, appearing to read "Cynthia B. Wilder". The signature is fluid and cursive, with the first name "Cynthia" being more prominent than the last name "Wilder".

Cynthia B. Wilder, Ph.D.

Patent Examiner

Art Unit 1637